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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/589,084	06/08/2000	Yoshikazu Kobayashi	071671/0153	9809

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FOLEY AND LARDNER  
SUITE 500  
3000 K STREET NW  
WASHINGTON, DC 20007

EXAMINER
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LAFORGIA, CHRISTIAN A

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 03/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/589,084

Applicant(s)

KOBAYASHI, YOSHIKAZU

Examiner

Christian La Forgia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. The amendment filed on 20 January 2004 is noted and made of record.
2. Claims 1 through 18 are presented for examination.

***Response to Arguments***

3. Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection.
4. See further rejections that follow.

***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,222,859 to Yoshikawa, hereinafter Yoshikawa, in view of U.S. Patent No. 6,690,654 to Elliott et al., hereinafter Elliott.
7. As per claim 1, Yoshikawa teaches a telephone communication system comprising:  
a public network (Figure 3 [block 4]; column 2, lines 57-65; column 5, lines 55-59),  
an ISP network (Figures 2, 3; column 2, lines 18-23; column 5, lines 47-51), and  
a plurality of telephone sets accommodated in the public network (Figures 1, 2 [blocks T151-T153], 3 [blocks 1, 2], 4; column 2, lines 22-28; column 5, lines 47-51; column 6, lines 5-10),  
  
wherein when a calling telephone set, which is a subscriber to the ISP network provides connection point data specific to said ISP network for making internet service telephone communication to a called telephone set, said connection point data provided using the public

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network, the called telephone set receiving the connection point data from the public network and connecting itself to the ISP network according to the connection point data, and the calling telephone set connecting itself to the ISP network (column 7, lines 25-42; column 11, lines 28-40).

8. Yoshikawa does not teach wherein said called and calling parties are connected for making said internet service telephone communication using the same ISP network.

9. Elliot discloses wherein said called and calling parties are connected for making said internet service telephone communication using the same ISP network in column 4, lines 20-33. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the calling parties connect over the same ISP network or a VPN, since it has been held in the art that virtual private networks use encryption technology so messages are safe from being intercepted and understood by unauthorized users.

10. As per claim 2, Yoshikawa teaches a telephone communication system comprising:  
a public network (Figure 3 [block 4]; column 2, lines 57-65; column 5, lines 55-59),  
an ISP network (Figures 2, 3; column 2, lines 18-23; column 5, lines 47-51), and  
a plurality of telephone sets accommodated in the public network (Figures 1, 2 [blocks T151-T153], 3 [blocks 1, 2], 4; column 2, lines 22-28; column 5, lines 47-51; column 6, lines 5-10),

wherein when a calling telephone set, which is a subscriber to the ISP network provides connection point data specific to said ISP network for making internet service telephone communication to a called telephone set, said connection point data provided using the public

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network, the called telephone set receiving the connection point data from the public network and connecting itself to the ISP network according to the connection point data, and the calling telephone set connecting itself to the ISP network (column 7, lines 25-42; column 11, lines 28-40),

the connection point data including at least an IP address in the ISP network and a telephone number of a point to be connected to the ISP network (column 5, lines 60-67; column 7, lines 25-42; column 11, lines 28-40).

11. Yoshikawa does not teach wherein said called and calling parties are connected for making said internet service telephone communication using the same ISP network.

12. Elliot discloses wherein said called and calling parties are connected for making said internet service telephone communication using the same ISP network in column 4, lines 20-33. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the calling parties connect over the same ISP network or a VPN, since it has been held in the art that virtual private networks use encryption technology so messages are safe from being intercepted and understood by unauthorized users.

13. As per claim 3, Yoshikawa teaches a telephone communication system comprising:  
a public network (Figure 3 [block 4]; column 2, lines 57-65; column 5, lines 55-59),  
an ISP network (Figures 2, 3; column 2, lines 18-23; column 5, lines 47-51), and  
a plurality of telephone sets accommodated in the public network (Figures 1, 2 [blocks T151-T153], 3 [blocks 1, 2], 4; column 2, lines 22-28; column 5, lines 47-51; column 6, lines 5-10),

wherein when a calling telephone set, which is a subscriber to the ISP network provides connection point data specific to said ISP network for making internet service telephone communication to a called telephone set, said connection point data provided using the public network, the called telephone set receiving the connection point data from the public network and connecting itself to the ISP network according to the connection point data, and the calling telephone set connecting itself to the ISP network (column 7, lines 25-42; column 11, lines 28-40),

the connection point data including at least an IP address in the ISP network and the telephone number of a point to be connected to the ISP network (column 5, lines 60-67; column 7, lines 25-42; column 11, lines 28-40),

14. Yoshikawa does not teach a push-button telephone set having various function keys being provided between each of the plurality of telephone sets and the public network with a function of sending out a call from each telephone set. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a push-button telephone since the Examiner takes Official Notice of the equivalence of computer terminals for their use in the phone calling art and the selection of any of these known equivalents to a computer terminal with phone calling capabilities would be within the level of ordinary skill in the art.

15. Yoshikawa does not teach wherein said called and calling parties are connected for making said internet service telephone communication using the same ISP network.

16. Elliot discloses wherein said called and calling parties are connected for making said internet service telephone communication using the same ISP network in column 4, lines 20-33. It would have been obvious to one of ordinary skill in the art at the time the invention was made

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to have the calling parties connect over the same ISP network or a VPN, since it has been held in the art that virtual private networks use encryption technology so messages are safe from being intercepted and understood by unauthorized users.

17. Regarding claims 4, 11, and 12, Yoshikawa teaches wherein functions of each telephone set are executed on a personal computer (Figure 4; column 6, lines 5-65).

18. Regarding claims 5, 13, and 14, Elliott teaches wherein functions of each telephone set are executed with an IVR (interactive voice response) unit or a facsimile data server or a voice recognition dialer or a voice mail (column 4, lines 48-65).

19. Regarding claims 6, 15 and 16, Yoshikawa teaches:

a telephone set control unit for detecting depressed push-buttons in the ten-key unit, obtaining the connection point data from the accumulating unit, sending out dial data and connection point data via the public network, starting the voice codec when the dialed side has been connected to the ISP network and, upon arrival of a call, retrieving the connection point data of the calling side, effecting connection to the ISP network by retrieving and referring to the accumulating unit according to the connection point data and informing the calling side of the connection (Figures 1, 2 [blocks T151-T153], 3 [blocks 1, 2], 4; column 2, lines 22-28; column 5, lines 47-51; column 6, lines 5-10);

a ten-key unit having dial keys and a function key for indicating an internet telephone service (Figure 4 [block 14]; column 6, lines 20-42);

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a display unit for displaying a call arrival notification and results of various processes in the telephone set (Figure 4 [block 15]; column 6, lines 32-42);

an accumulating unit for storing telephone number data and access identifier data of internet connection points to be connected by the calling and called sides (column 8, lines 31-48; column 9, lines 51-67; column 11, lines 27-40; column 13, lines 15-38);

a voice codec to be started by a command for voice communication in the ISP network (Figure 4 [block 18]; column 6, lines 52-55).

20. Regarding claims 7, 17, and 18, Yoshikawa teaches wherein each telephone set further comprises an encryption unit for permitting exchange of connection point data in terms of ciphers (column 8, lines 31-48).

21. As per claim 8, Yoshikawa teaches an Internet communication method comprising steps of:

providing, by a calling telephone set that is a subscriber to an ISP network, of connection point data, specific to said ISP, for making internet service telephone communication to a called telephone set, said connection point data being transmitted using a public network (column 7, lines 25-58; column 11, lines 28-50),

the called telephone set receiving the connection point data and connecting to the ISP network on the basis of the connection point data (column 5, lines 60-67; column 7, lines 25-42; column 11, lines 28-40), and

the calling telephone set connecting to the ISP network (column 7, lines 51-58).



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22. Yoshikawa does not teach wherein said called and calling parties are connected for making said internet service telephone communication using the same ISP network.

23. Elliot discloses wherein said called and calling parties are connected for making said internet service telephone communication using the same ISP network in column 4, lines 20-33.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the calling parties connect over the same ISP network or a VPN, since it has been held in the art that virtual private networks use encryption technology so messages are safe from being intercepted and understood by unauthorized users.

24. As per claim 9, Yoshikawa teaches an Internet communication method comprising steps of:

providing, by a calling telephone set that is a subscriber to an ISP network, of connection point data, specific to said ISP, for making internet service telephone communication to a called telephone set, said connection point data being transmitted using a public network (column 7, lines 25-58; column 11, lines 28-50),

the called telephone set receiving the connection point data from the public network and connecting to the ISP network on the basis of the connection point data (column 5, lines 60-67; column 7, lines 25-42; column 11, lines 28-40), and

the calling telephone set connects itself to the ISP network (column 7, lines 51-58),

the connection point data including at least an IP address in the ISP network and a telephone number of a point to be connected to the ISP network (column 5, lines 60-67; column 7, lines 25-42; column 11, lines 28-40).

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25. Yoshikawa does not teach wherein said called and calling parties are connected for making said internet service telephone communication using the same ISP network.

26. Elliot discloses wherein said called and calling parties are connected for making said internet service telephone communication using the same ISP network in column 4, lines 20-33.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the calling parties connect over the same ISP network or a VPN, since it has been held in the art that virtual private networks use encryption technology so messages are safe from being intercepted and understood by unauthorized users.

27. As per claim 10, Yoshikawa teaches an Internet communication method comprising steps of:

providing, by a calling telephone set that is a subscriber to an ISP network, of connection point data, specific to said ISP, for making internet service telephone communication to a called telephone set, said connection point data being transmitted using a public network (column 7, lines 25-58; column 11, lines 28-50),

the called telephone set receiving the connection point data from the public network and connecting to the ISP network on the basis of the connection point data (column 5, lines 60-67; column 7, lines 25-42; column 11, lines 28-40), and

the calling telephone set connecting to the ISP network (column 7, lines 51-58),

the connection point data including at least an IP address in the ISP network and a telephone number of a point to be connected to the ISP network (column 5, lines 60-67; column 7, lines 25-42; column 11, lines 28-40).

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28. Yoshikawa does not teach a push-button telephone set having various function keys being provided between each of the plurality of telephone sets and the public network with a function of sending out a call from each telephone set. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a push-button telephone since the Examiner takes Official Notice of the equivalence of computer terminals for their use in the phone calling art and the selection of any of these known equivalents to a computer terminal with phone calling capabilities would be within the level of ordinary skill in the art.

29. Yoshikawa does not teach wherein said called and calling parties are connected for making said internet service telephone communication using the same ISP network.

Elliot discloses wherein said called and calling parties are connected for making said internet service telephone communication using the same ISP network in column 4, lines 20-33. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the calling parties connect over the same ISP network or a VPN, since it has been held in the art that virtual private networks use encryption technology so messages are safe from being intercepted and understood by unauthorized users.

### ***Conclusion***

30. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

31. The following patents are cited to further show the state of the art with respect to Internet phone services, such as:

United States Patent No. 6,493,447 to Goss et al., which is cited to show contact server for call center for synchronizing simultaneous telephone calls and TCP/IP communications.

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United States Patent No. 6,654,815 to Goss et al., which is cited to show contact server for call center for synchronizing simultaneous telephone calls and TCP/IP communications.

United States Patent No. 6,404,873 to Beyda et al., which is cited to show sub-conference calling in a telephony-over-LAN environment.

United States Patent No. 6,707,827 to Shaffer et al., which is cited to show a method for optimizing audio response in telephony-over-LAN systems.

United States Patent No. 6,671,356 to Lewis, which is cited to show multimedia communications management system with subscriber messaging integration services.

32. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

33. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

34. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian La Forgia whose telephone number is (703) 305-7704.

The examiner can normally be reached on Monday thru Thursday 7-5.

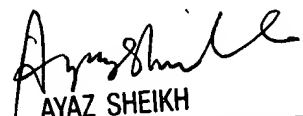
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35. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (703) 305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

36. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christian LaForgia  
Patent Examiner  
Art Unit 2131

clf

  
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SUPERVISORY PATENT EXAMINER  
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